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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,738	01/27/2004	Roland Hengerer	10022-580	2842
28164	7590	08/09/2006		EXAMINER
ACCENTURE CHICAGO 28164				DESTA, ELIAS
BRINKS HOFER GILSON & LIONE				
P O BOX 10395			ART UNIT	PAPER NUMBER
CHICAGO, IL 60610				2857

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/766,738	HENGERER, ROLAND
	Examiner	Art Unit
	Elias Desta	2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 September 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **Detailed Action**

### **Response to Appeals Brief**

1. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is considered and, therefore, the finality of that action is withdrawn.

### **Specification**

2. The specification is objected to because of the following minor informalities:

Page 5, paragraph 31: constants  $\alpha_1$  and  $\alpha_2$  represent decay constant not 'time constant'. Appropriate correction is required.

### **Claim rejection – 35 U.S.C. 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-12 are rejected under 35 U.S.C.101 because the claimed invention is directed to non-statutory subject matter and for lack of patentable utility.

#### Non-statutory subject Matter

In reference to claims 1, 8 and 12: "Determining the age of the object", "determining the freshness of the goods" or having a calculating unit for "calculating a current scent ratio" does not amount to a "useful, concrete and tangible" outcome.

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is “concrete, tangible and useful”. Referring to the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” in determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

In claims 1 and 8, the final step of “determining the age of the object” and “freshness of goods” respectively is not realized as a “useful, tangible and concrete” outcome. In other words, the outcome has to be presented outside the computing structure where a new or improved process is explored. Further, the system (claim 12) that calculates the scent ratio is not “a useful concrete and tangible” outcome. The claims lack a subsequent step (s) such as useful steps that may be displayed to the user as an output on a screen with a known relationship, a new process over the existing practice that can be realized or an improvement thereof, which would have helped to realize a “useful, concrete and tangible” output.

In reference to claims 10 and 11: Determining a reference scent ratio ( $\sigma_0$ ) does not amount to a “useful, concrete and tangible” outcome.

As noted above, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is “concrete, tangible and useful”. Referring to the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” in determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a

particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

In the instant claim, determining the scent ratio does not amount to a useful, concrete and tangible result. In order to make the outcome as "a useful, concrete and tangible" output, a subsequent step (s) would have to be taken so that a new or an improved process may be realized.

#### Utility

In reference to claims 1, 8 and 12: the disclosed invention is inoperative and therefore lacks utility. The base or reference scent value is arbitrarily chosen and then compared to another scent value in order to establish a ratio; however, the ratio defined in the system as a whole may not produce real world value that provides substantial or well-established utility. The unknown function  $\eta(\xi(t))$  cannot be identical for the two different sensors of the electronic nose with different decay constant. If eta ( $\eta(\xi(t))$ ) is considered the same, then  $\alpha_1 = \alpha_2, I_1 = I_2, \dots$  etc. which would make the alleged equation invalid. It is not apparent how an unknown function  $\eta(\xi(t))$  with so many variable factors that is applied to two different sensors would have exactly the same functional representation without having a significant error factor.

In reference to claim 9: the claim is not supported by a well-established utility because applicant's statement of the characteristics of the first and second volatile components is not known or defined. The volatile identification code is not described in the specification as having an interpretable code, such as color, barcode or other means known in the art. A person having ordinary skill in the art would not have known how these volatile components sprayed on an object define a quantifiable data to establish a volatile identification code.

In reference to claims 10 and 11: claims 10 and 11 are inoperative and therefore lack utility. As noted above, the unknown function  $\eta(\xi(t))$  cannot be the identical for the two different sensors of the electronic nose with different decay constant. Therefore, the scent ratio is an over simplification or derivation of an equation from two scent intensity equations (see pages 4-5 of the instant specification) which are based upon on the unknown or indefinite variable ( $\eta(\xi(t))$ ) assigned for the two sensors. As a result, the scent ratio as noted in equation 2 of the instant application (see page 5 of the instant specification) would not be realized in claims 10 and 11.

### **Claim rejection – 35 U.S.C. 112**

5. Claims 1-12 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elias Desta whose telephone number is (571)-272-2214. The examiner can normally be reached on M-Th (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571)-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

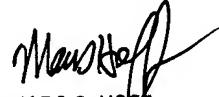
7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elias Desta  
Examiner  
Art Unit 2857

- E.d

- August 3, 2006



MARC S. HOFF  
SUPERVISORY PATENT EXAMINER  
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